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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,391	03/23/2004	Kunio Kondo	12112-0003	2333

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EXAMINER

YEE, DEBORAH

ART UNIT PAPER NUMBER

1742

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,391

Applicant(s)

KONDO, KUNIO

Examiner

Deborah Yee

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 7, 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 407041856 .

4. The English abstract of JP'856 discloses a seamless bainitic steel pipe having a composition with constituents whose wt% ranges overlap those recited by claims 1 to 4; such overlap renders applicant's composition prima facie obvious because it would be obvious for one skilled in the art to select the claimed alloy wt% ranges over the broader disclosure of the prior art since prior art teaches the same utility (seamless pipe used for machined structure), see MPEP 2144.05.

5. Moreover, JP'856 on page 5 discloses specific alloy examples A, B and E having compositions that closely approximate those recited by the claims and when calculated, meet the Ceq equation recited by the claim 1. Even though prior art does not teach the equation claimed, such would not be a patentable difference since it has been held that there is no invention involved in the discovery of a general formula if it covers a composition described in the prior art.

6. Claims 1 to 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 5-202447 (Eiji) for the reasons set forth in the office actions dated 6-06-05 and 11-14-05.

Response to Arguments

7. Applicant's arguments filed 2-14-06 have been fully considered but they are not persuasive. It was submitted that applicant's newly amended C range has an upper limit of 0.17% whereas Eiji steel contains a lower carbon limit of 0.2%. Since there is no overlap then Eiji cannot be relied upon to allege that claim 1 is obvious under 35 USC 103. It is examiner's position that a prima facie case of obviousness does exist because C limits are close enough that one skilled in the art would have expected them to have the same properties since applicant has not established criticality (e.g. by comparative test data) for the upper C limit of 0.17%. See MPEP 2144.05.

8. It was argued that criticality of 0.1 to 0.17% C has been demonstrated by comparative data on page 10 of applicant's specification. It is the examiner's position

that the comparative examples are ineffective because they are not representative of the prior art alloys. Note that even though comparative example 26 contains 0.19% C, it also contains very low Mn outside the prior art range; and therefore not representative of the prior art alloy.


9. Moreover, prior art on page 6 teaches steel exhibiting high tensile strength, high toughness and no weld cracks at values similar to those disclosed in applicant's specification on page 10; hence claims would not patentably distinguish over prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Deborah Yee
Primary Examiner
Art Unit 1742

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